

REMARKS

Claims 1-51 are pending in the present application. Applicants have amended claim 12 by way of this response. Claims 1, 4, 10, 12, 13, 16, 17, 23, 25, 27, 30, 37, 39, 41, 44, and 49 are independent claims.

ALLOWABLE SUBJECT MATTER

Initially, Applicants acknowledge and thank the Examiner for the allowance of claims 1-3 and 5-9.

CLAIM AMENDMENTS

Applicants have amended claim 12 by way of this response. Applicants assert the all such amendments to claim 12 are non-narrowing; have not been made for any reason related to patentability; and have been made for no other reason other than to put claims 12 in accordance with proper U.S.P.T.O. Practice and Procedure.

PRIOR ART REJECTIONS

Mattaway et al.

Claims 4 and 10-51 stand rejected under 35 U.S.C. §102(e) as being anticipated by Mattaway et al. (U.S. Patent No. 6,009,469, hereinafter referred to as Mattaway).

Applicants respectfully traverse this rejection.

Mattaway is directed to a communication utility for establishing point-to-point communications between processes over a computer network. Specifically, with regard to FIG. 15A, Mattaway discloses a global server 1500 and various devices (e.g. ISP 1528, CSU/DSU 1526) operatively coupling the global server to the internet 1530. A Webphone

1536, is coupled to the internet 1530 through an Internet service provider (hereinafter ISP) 1532. Global server 1500 further includes a database 1516 which interacts with control server 1512 and information server 1514 through database server 1518. Database 1516 includes a Client table 1516A, an On-line table 1516B, a WebBoard table 1516C a Web Board configuration table 1516D and a WebBoard source table 1516E.

Further, Client Table 1516A includes a separate record corresponding to each Webphone user (i.e. client), and each record includes information defining the client's profile of personal information (see col. 20 lines 27-35).

With regard to claims 4, 10 and 12, Mattaway fails to teach or suggest a method of operating a Personal Digital Assistant including the arranging step performed within the PDA. The Examiner has apparently relied upon Mattaway (col. 20, lines 27-35) for the alleged teaching of the arranging step within the PDA.

Col. 20, lines 27-35 of Mattaway recites:

"Client table 1516A comprises a plurality of records, each of which may have the fields and corresponding data elements as described in Table 1. Each WebPhone user, hereinafter "client," has a separate record in table 1516A containing the information defining the client's profile of personal information. In Table 1, the "activated," "paid," and "published" fields are boolean yes/no fields. The "id" field comprises a unique ID sequence identifying a particular WebPhone client." (Emphasis added)

The client table 1516A, as disclosed by Mattaway, is located in a database 1516, which is further included in a global server 1500 (see Mattaway col. 20, lines 16-17 and FIG. 15A). Each Webphone user (i.e. Client), has a separate record in the Table 1516A, including information defining an individual "clients profile of personal information" (see Mattaway, col. 20, lines 31-32). However, Mattaway makes no mention

or suggestion of arranging this information in a personal digital assistant. In contrast, Mattaway merely discloses the storage of information in a database within a global server 1500 (see FIG. 15A) which is in communication with the WebPhone, as shown in FIG. 15A of Mattaway.

Thus, Mattaway does not teach or suggest at least “arranging information within the PDA to correspond to at least one of first and second data sets”, as currently recited in claims 4, 10 and 12.

RESPONSE TO EXAMINER’S ARGUMENTS

In paragraphs 6 and 7 of the outstanding Office Action, dated May 20, 2004, the Examiner asserts that “It would have been inherent to prestore identity information in the PDA because security is a concern in Mattaway.”

However, Applicants respectfully assert that the Examiner’s claim of inherency is incorrect, and thus, the rejection under 35 U.S.C. §102(e) as being anticipated by Mattaway is improper.

The Examiner Must Provide Rationale or Evidence Tending to Show Inherency

MPEP § 2112 recites:

“The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)” (emphasis added)

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows

from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)"

The Examiner's alleged motivation for the inherent prestoring of information in Mattaway is "because security is a concern in Mattaway" (see paragraphs 6 and 7 of the outstanding Office Action, dated May 20, 2004). However, Applicants respectfully submit that the Examiner's has provided no basis in fact nor technical reasoning which would reasonably support the determination that the ***prestoring of information in the Personal Digital Assistant*** necessarily flows from Mattaway. In view of the above discussion of MPEP § 2112, Applicants respectfully assert that the Examiner's alleged motivation for the inherent prestoring of security information in Mattaway is incorrect.

As such, Applicants respectfully assert that Mattaway does not teach or suggest all of the limitations as currently recited in claim 4, 10 and 12, and thus, respectfully request that this rejection be withdrawn.

With regard to claims 11 and 13-51, Applicants respectfully assert similar arguments apply to each of claims 11 and 13-51, however, each of the claims should be governed solely by the limitations present therein and should not be limited in any way by limitations or arguments set forth in other independent claims.

Thus, Applicants respectfully assert that these claims are allowable for at least the reasons as discussed above with respect to claim 4, 10, and 12, and as such, respectfully request that the rejections of claims 11 and 13-51 be withdrawn.

Should the Examiner not find Applicant's arguments persuasive as to claims 11 and 13-51, Applicants respectfully request that the Examiner clearly designate the portion of Mattaway that teaches the features as discussed above.

Pardo

Claims 16, 18, 27, 30, 33, 41, 44, 46, and 49 stand rejected under 35 U.S.C. §102(e) as being anticipated by Pardo (U.S. Patent No. 6,266,539, hereinafter referred to as Pardo).

Applicants respectfully traverse this rejection.

Pardo discloses a telephone docking station that allows a personal digital assistant (PDA) to be connected to it. Pardo's telephone docking station includes telephone circuitry, which performs basic telephone functions and a modem. Pardo discloses that the connected PDA can be used to perform automatic dialing of stored phone numbers, browse the Worldwide Web, or implement features including three-way calling, call forwarding, or caller-id blocking.

With regard to claim 16, Pardo fails to teach or suggest selecting and/or programming, within the Personal Digital Assistant, "at least one of the user's personal phone policies being used to implement at least one of the user's personal phone features in a telecommunication system."

In contrast, the PDA, as disclosed by Pardo, provides all communication functionality, other than the basic telephony services and modem functionality, which are provided by the telephone docking station. Thus, any phone features disclosed in Pardo are not implemented in the telecommunication system (telephone network), but instead, remain within, and are performed by, the PDA. Therefore, Applicants respectfully assert that Pardo fails to teach or suggest at least "allowing a user to select and program the user's personal phone features and phone policies within the PDA from the stored list of phone features and phone policies, at least one of the user's personal phone policies

being used to implement at least one of the user's personal phone features in a telecommunication system", as currently recited in claim 16.

Applicants further assert that claim 18 is allowable for at least the reasons as discussed above with respect to independent claim 16, from which it depends.

With regard to claims 27, 30, 33, 41, 44, 46 and 49, Applicants respectfully assert similar arguments apply to each of claims 27, 30, 33, 41, 44, 46 and 49, however, each of the claims should be governed solely by the limitations present therein and should not be limited in any way by limitations or arguments set forth in other independent claims.

Thus, Applicants respectfully assert that these claims are allowable for at least the reasons as discussed above with respect to claim 16, and as such, respectfully request that the rejections of claims 16, 18, 27, 30, 33, 41, 44, 46 and 49 be withdrawn.

Should the Examiner not find Applicant's arguments persuasive as to claims 27, 30, 33, 41, 44, 46, and 49, Applicants respectfully request that the Examiner clearly designate the portion of Pardo that teaches the features as discussed above.

CONCLUSION

In view of above remarks, reconsideration of the outstanding rejection and allowance of all pending claims is respectfully requested.


If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Andrew M. Waxman, Reg. No. 56,007, at the number of the undersigned listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, P.L.C.

By


Gary D. Yacura
Reg. No. 35,416

GDY/AMW:jcp

P.O. Box 8910
Reston, VA 20195
(703) 668-8000